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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,429	09/15/1999	JOHN S. HENDRICKS	SEDN/5815	7434

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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/396,429

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y. Koenig

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,14,18,19,23,24,28-32,37,40-43,45-50,52-56 and 58-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,14,18,19,23,24,28-32,37,40-43,45-50,52-56 and 58-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 November 2007 has been entered.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed 14 November 2007 is insufficient to overcome the rejection of claims 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52, 53, 55, 56, and 58-64 based upon 35 USC 112—first paragraph as set forth in the last Office action.

The declaration has been considered, but has been given nominal weight in that the applicant has submitted no evidence to support the history of PCMCIA nor that upon reading the PCMCIA specification one would readily recognized its use within a set-top terminal

In the response received 01 February 2005, the applicant argues that OEMs manufacturers of the set top terminals did not manufacture workstations, and workstation and computer OEM manufacturers did not produce set top terminals, as they are completely distinct industries (see remarks page 17 of 22, para. 2). The

examiner notes that the instant specification does not convey PCMCIA, but merely that the card is insertable into the set top terminal. As such, the declaration fails to establish that one skilled in the art would have been able to make and use the invention as of the instant filing date (09/15/99) or the earlier dates (12/2/93 or 12/9/92).

Response to Arguments

3. Applicant's arguments with respect to claims 30-32, 34, 37, 40-41, 45-50, 55, 56 and 58-59 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3-9, 14, 18, 19, 23, 24, 28, 29, 42, 43, 45-50, 52-56, and 58-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding independent claims 1, 14, 24, 42, and 60, The specification provides support for a hardware upgrade card insertable into the set top terminal to add a data modulation and demodulation function to the set top terminal. However, the specification does not describe a way to enable one skilled in the art to make the

connection. The specification merely discusses that it is electrically connected either a serial or parallel interface, but does not discuss which serial or parallel interface is being used (see specification: pg. 37, ll. 8-26). The specification's supports a module upgrade using of a SCSI port, but this appears to be used for external connections and not inserted into the set top terminal. Further the state of the prior art does not appear to provide insight on how to make this connection with a set top terminal.

The examiner notes that the embodiments using multipin connections (DB9, DB25, or SCSI) are directed to upgrade module 300 (pg. 30, ll. 8-13) for a simple decompression box 302, which is separate from the modem upgrade as shown in figure 12a.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30-32, 34, 37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzi (U.S. Patent 5,327,554) in view of Banker et al. (Banker) (U.S. Patent 5,357,276) and Reiter (U.S. Patent 4,751,578).

Considering claim 30, Banker discloses a television terminal (40,44, or 48) having microprocessor (128,136) instructions for prompting generation of menus, the television terminal comprising:

a) a television program receiver (100,150) for receiving television programs from one or more headends (10);

b) an interface (124, 126) to the television terminal for receiving and processing subscriber input (col. 5, lines 7-25);

c) modem (col. 4, lines 40-50) communicating with one or more headend (10), wherein the receiver receives television program signals based on subscriber input (see the entire reference including but not limited to col. 4, lines 40-57), wherein the terminal downloads data from one or more headends to a local storage (col. 6, line 59 – col. 7, line 3 and col. 7, lines 24-28);

d) an output (142, TV 42) connected to the receiver (100,150) and the modem, wherein the output accepts television program signals from the receiver.

Banker fail to specifically disclose an output that accepts data signals from the modem and a modem that downloads data from one or more headend to a local storage, wherein the data comprising information from an interactive service for accessing an on-line database thereby allowing actual transactions using two-way communications over the modem with the interactive service via submenus as recited in the claim.

Palazzi discloses a television terminal comprising a television program receiver (11), a modem (4) an output (9, 10, 15) connected to the receiver (11) and modem (4),

wherein the output accepts television program signals from the receiver and data signals from the modem and wherein the modem downloads data from one or more central facility (headend) to a local storage, wherein the data comprises information from an interactive service for accessing an on-line database thereby allowing actual transactions using two-way communications over the modem with the interactive service via submenus. Palazzi's system provides an efficient system for creating an interactive display terminal for accessing information stored at a central facility and for downloading data for later retrieval. See abstract, col. 3, line 64 - col. 4, line 44 and col. 6, lines 17-38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker's system to include an output that accepts data signals from a modem and a modem that downloads data from a central facility (such as a headend) to a local storage, wherein the data comprises information from an interactive service for accessing an on-line database thereby allowing actual transactions using two-way communications over the modem with the interactive service via submenus as taught by Palazzi, for the advantages of providing an efficient interactive display terminal that accesses information stored at a central facility and downloads data to a local storage for later retrieval.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker's system (if necessary) to include downloading data from a headend to local storage in a television terminal via a modem

since Palazzi demonstrated that modems are used to receive data for local storage in a television terminal from central facilities.

Palazzi and Banker both teaches the use of modems, further Banker teaches the use of a modem in a set top terminal; however Palazzi and Banker are silent on a set top terminal with a modem hardware upgrade.

In analogous art, Reiter teaches upgrade modules such as a modem, where a modem by definition is a modulator and demodulation, and thus adds data modulation and demodulation to the television terminal (col. 3, ll. 47-51, col. 4, ll. 40-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker and Palazzi by using a modem upgrade module and adding data modulation and demodulation to the television terminal with the upgrade as taught by Reiter in order to provide an upgradeable set top terminal thereby increasing the functionality of the device while permitting the user to add hardware for additional functionality.

The combined systems of Banker and Palazzi, wherein Palazzi discloses interactive services/on-line databases provided by the host databases that are external to the television program delivery system throughout the entire reference including but not limited to column 1, line 5 - column 4, line 45, column 5, lines 63-66 and column 9, line 60 - column. 10, line 35.

Claim 31 is met by the combined systems of Banker and Palazzi, wherein Banker discloses television (42,46 or 50, figure 1) and Palazzi discloses television (15).

Claim 32 is met by the combined systems of Banker and Palazzi, wherein Palazzi discloses a connector port (10) and Banker's modulator (142) is inherently connected to television (42) via a connector port.

Claim 34 is met by the combined systems of Banker and Palazzi, wherein Banker discloses a memory (137,134) and Palazzi discloses a memory at col. 6, lines 18-45, 53-54, col. 7, lines 62-68 and col. 9, lines 20-40.

Claim 37 is met by the combined systems of Banker and Palazzi, wherein Palazzi discloses interactive services/on-line databases provided by the host databases that are external to the television program delivery system throughout the entire reference including but not limited to column 1, line 5 - column 4, line 45, column 5, lines 63-66 and column 9, line 60 - column. 10, line 35.

Claim 40 are met by the combined systems of Banker and Palazzi, wherein Palazzi discloses online database(s) containing travel information, stock quotation and other data throughout the reference including but not limited to col. 1, lines 15-23, col. 3, lines 25-60 and col. 9, line 60 - col. 10, line 35.


Claim 41 are met by the combined systems of Banker and Palazzi, wherein Palazzi discloses HDTV capability in col. 6, lines 55-64.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig
Primary Examiner
Art Unit 2623

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